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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,957	05/20/1999	JUNICHI IIDA	P17946	5848

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EXAMINER
POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/314,957	IIDA, JUNICHI	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 May 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3-6,8,9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statements submitted on 8/20/99, 6/14/00, 12/20/00, 11/8/01, 10/21/02, and 11/5/02 have been considered by the examiner (see attached PTO-1449's).

Drawings

3. The drawings received on 5/20/99 are acceptable by the examiner, and have been approved by the Official Draftsman (see attached PTO-948).

Response to Preliminary Amendment

4. Applicant's preliminary amendment was received on 8/23/02, and has been entered and made of record. Currently, **claims 20-45** are pending.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 20, 21, 23-25, 29-34, 36-38, and 42-45** are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (U.S. Patent Number 5,608,786).

Regarding ***claim 20***, Gordon discloses a communication apparatus (UniPost Access Node 6) connected to a terminal apparatus (computer 12, see Fig. 3) via a network (public switched telephone network 10 or internet 4, see Figs. 1-5), with the communication apparatus comprising a receiver that receives e-mail data via the network (see abstract, and column 4, line 22 through column 5, line 11), a memory that stores the received e-mail data (see Figs. 2 and 3, column 6, lines 34 through 58), a generator that generates management data corresponding to the stored e-mail data (column 6, line 59 through column 7, line 13, and column 10, lines 22 through 63), as a structured document (column 10, lines 22 through 63), the management data including sender data of the e-mail data ("Sender ID", in column 10, lines 37 through 49), and a server that transmits the management data to the terminal apparatus when a request for the management data is received from the terminal apparatus (column 6, line 59 through column 7, line 67), the management data being displayable at the terminal apparatus (column 10, line 21 through column 11, line 14).

Regarding ***claim 21***, Gordon discloses the apparatus discussed above in claim 20, and further teaches that the memory stores a plurality of e-mail data, and the generator generates a list of management data (column 10, lines 28 through 59).

Regarding ***claim 23***, Gordon discloses the apparatus discussed above in claim 20, and further teaches that the management data includes at least a time at which the e-mail data corresponding to the management data is stored in the memory (column 10, lines 28 through 59, "Time").

Regarding ***claim 24***, Gordon discloses the apparatus discussed above in claim 20, and further teaches that the sender data comprises an origination address (column 10, lines 28 through 59, see listings under "Sender ID").

Regarding ***claim 25***, Gordon discloses the apparatus discussed above in claim 20, and further teaches that the terminal apparatus comprises a personal computer with a display (column 10, lines 28 through 55).

Regarding ***claim 29***, Gordon discloses the apparatus discussed above in claim 20, and further teaches that the generator assigns a specific number to each management data, the specific number being utilized to identify each management data (column 4, lines 27 through 56).

Regarding ***claim 30***, Gordon discloses a communication apparatus (UniPost Access Node 6) connected to a terminal apparatus (computer 12, see Fig. 3) via a network (public switched telephone network 10 or internet 4, see Figs. 1-5), with the communication apparatus comprising a receiver that receives e-mail data via the network (see abstract, and column 4, line 22 through column 5, line 11), a memory that stores the received e-mail data (see Figs. 2 and 3, column 6,

lines 34 through 58), a generator that generates management data corresponding to the stored e-mail data (column 6, line 59 through column 7, line 13, and column 10, lines 22 through 63), as a structured document (column 10, lines 22 through 63), the management data including sender data of the e-mail data ("Sender ID", in column 10, lines 37 through 49), a server that transmits the management data to the terminal apparatus when a request for the management data is received from the terminal apparatus (column 6, line 59 through column 7, line 67), the management data being displayable at the terminal apparatus (column 10, line 21 through column 11, line 14), and a controller that controls the stored e-mail data in accordance with a command transmitted from the terminal apparatus via the network (column 7, lines 21 through 50, and column 10, line 50 through column 11, line 5).

Regarding ***claim 31***, Gordon discloses the apparatus discussed above in claim 30, and further teaches that the controller controls transmission of the stored e-mail data to a destination in accordance with the command from the terminal apparatus (column 4, line 51 through column 5, line 11, and column 10, line 31 through column 11, line 5).

Regarding ***claim 32***, Gordon discloses the apparatus discussed above in claim 30, and further teaches of a converter that converts the stored e-mail data into image data, and a printer (being an inherent printer inside a facsimile machine) that prints the converted image data, wherein the controller controls printing of the converted e-mail data in accordance with the command from the terminal apparatus (column 4, line 62 through column 5, line 11, column10, line 66 through column11, line 5).

Regarding ***claim 33***, Gordon discloses a method using a communication apparatus (UniPost Access Node 6) connected to a terminal apparatus (computer 12, see Fig. 3) via a

network (public switched telephone network 10 or internet 4, see Figs. 1-5) comprising receiving e-mail data via the network (see abstract, and column 4, line 22 through column 5, line 11), storing the received e-mail data into a memory of the communication apparatus (see Figs. 2 and 3, column 6, lines 34 through 58), generating management data corresponding to the stored e-mail data (column 6, line 59 through column 7, line 13, and column 10, lines 22 through 63), as a structured document (column 10, lines 22 through 63), the management data including sender data of the e-mail data ("Sender ID", in column 10, lines 37 through 49), and transmitting the management data to the terminal apparatus when a request for the management data is received from the terminal apparatus (column 6, line 59 through column 7, line 67), the management data being displayable at the terminal apparatus (column 10, line 21 through column 11, line 14).

Regarding ***claim 34***, Gordon discloses the method discussed above in claim 33, and further teaches that the storing stores a plurality of e-mail data into the memory, and the generating generates a list of management data (column 10, lines 28 through 59).

Regarding ***claim 36***, Gordon discloses the method discussed above in claim 33, and further teaches that generating the management data includes generating at least a time at which the e-mail data corresponding to the management data is stored in the memory (column 10, lines 28 through 59, "Time").

Regarding ***claim 37***, Gordon discloses the method discussed above in claim 33, and further teaches that the sender data comprises an origination address (column 10, lines 28 through 59, see listings under "Sender ID").

Regarding ***claim 38***, Gordon discloses the method discussed above in claim 33, and further teaches that the terminal apparatus comprises a personal computer with a display (column 10, lines 28 through 55).

Regarding ***claim 42***, Gordon discloses the method discussed above in claim 33, and further teaches that the generator assigns a specific number to each management data, the specific number being utilized to identify each management data (column 4, lines 27 through 56).

Regarding ***claim 43***, Gordon discloses a communication method using a communication apparatus (UniPost Access Node 6) connected to a terminal apparatus (computer 12, see Fig. 3) via a network (public switched telephone network 10 or internet 4, see Figs. 1-5) comprising receiving e-mail data via the network (see abstract, and column 4, line 22 through column 5, line 11), storing the received e-mail data into a memory (see Figs. 2 and 3, column 6, lines 34 through 58), generating management data corresponding to the stored e-mail data (column 6, line 59 through column 7, line 13, and column 10, lines 22 through 63), as a structured document (column 10, lines 22 through 63), the management data including sender data of the e-mail data ("Sender ID", in column 10, lines 37 through 49), transmitting the management data to the terminal apparatus when a request for the management data is received from the terminal apparatus (column 6, line 59 through column 7, line 67), the management data being displayable at the terminal apparatus (column 10, line 21 through column 11, line 14), and controlling the stored e-mail data in accordance with a command transmitted from the terminal apparatus via the network (column 7, lines 21 through 50, and column 10, line 50 through column 11, line 5).

Regarding ***claim 44***, Gordon discloses the method discussed above in claim 43, and further teaches that the controlling controls transmission of the stored e-mail data to a destination in accordance with the command from the terminal apparatus (column 4, line 51 through column 5, line 11, and column 10, line 31 through column 11, line 5).

Regarding ***claim 45***, Gordon discloses the method discussed above in claim 43, and further teaches of converting the stored e-mail data into image data, and printing the converted image data (through an inherent printer inside a facsimile machine), wherein the converted e-mail data is printed in accordance with the command from the terminal apparatus (column 4, line 62 through column 5, line 11, column10, line 66 through column11, line 5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 22, 27, 28, 35, 40, and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (U.S. Patent Number 5,608,786) in view of Hsiao (U.S. Patent Number 5,848,137).

Regarding ***claim 22***, Gordon discloses the apparatus discussed above in claim 20, but fails to specifically teach if the memory stores a TIFF file attached to the e-mail data. Hsiao discloses a communication apparatus connected to a terminal apparatus via a network (see Figs. 1 and 2), with the communication apparatus comprising a receiver that receives e-mail data via

the network (column 3, lines 34 through 45, and column 4, lines 40 through 53), a memory (storage unit 90) that stores the received e-mail data (column 4, lines 40 through 53), a generator that generates management data corresponding to the stored e-mail data, as a structured document (see Fig. 3, column 5, line 36 through column 6, line 9). Hsiao further teaches that the memory stores a TIFF file attached to the e-mail data (column 3, line 54 through column 4, line 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hsiao's teachings in the system of Gordon. Gordon's system would easily be modified to include the teachings of Hsiao, since the systems share cumulative features, being additive in nature.

Regarding ***claim 27***, Gordon discloses the apparatus discussed above in claim 20, and further teaches of a facsimile receiver that receives facsimile data via a telephone network (see abstract, and column 5, lines 32 through 40), and a converter that converts the received facsimile data into a data file (column 4, line 62 through column 5, line 11, and column 6, lines 4 through 20), wherein the memory stores the data file (column 6, lines 34 through 58), and the generator generates management data corresponding to the data file as a structured document (column 10, lines 31 through 65). However, Gordon fails to specifically teach of converting the received facsimile data into a TIFF file, wherein the memory stores the TIFF file, and the generator generates management data corresponding to the TIFF file as a structured document. Hsiao discloses a communication apparatus connected to a terminal apparatus via a network (see Figs. 1 and 2), with the communication apparatus comprising a receiver that receives e-mail data via the network (column 3, lines 34 through 45, and column 4, lines 40 through 53), a memory (storage unit 90) that stores the received e-mail data (column 4, lines 40 through 53), a generator

that generates management data corresponding to the stored e-mail data, as a structured document (see Fig. 3, column 5, line 36 through column 6, line 9). Hsiao further teaches of a facsimile receiver that receives facsimile data via a telephone network (column 3, lines 34 through 60), and a converter that converts the received facsimile data into a TIFF file (column 3, line 46 through column 4, line 24), wherein the memory stores the TIFF file (column 3, lines 54 through 57), and the generator generates management data corresponding to the TIFF file as a structured document (see Fig. 3, and column 3, line 46 through column 4, line 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hsiao's teachings in the system of Gordon. Gordon's system would easily be modified to include the teachings of Hsiao, since the systems share cumulative features, being additive in nature.

Regarding ***claim 28***, Gordon and Hsiao disclose the apparatus discussed above in claim 27, and Gordon further teaches of a determining section that determines whether the data was received via the network or the telephone network (column 10, lines 31 through 49, see listings under "Type").

Regarding ***claim 35***, Gordon discloses the method discussed above in claim 33, but fails to specifically teach if the storing stores a TIFF file attached to the e-mail data. Hsiao discloses a communication method using a communication apparatus connected to a terminal apparatus via a network (see Figs. 1 and 2) comprising receiving e-mail data via the network (column 3, lines 34 through 45, and column 4, lines 40 through 53), storing the received e-mail data into a memory of the communication apparatus (storage unit 90, column 4, lines 40 through 53), and generating management data corresponding to the stored e-mail data, as a structured document (see Fig. 3,

column 5, line 36 through column 6, line 9). Hsiao further teaches that the storing stores a TIFF file attached to the e-mail data (column 3, line 54 through column 4, line 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hsiao's teachings in the system of Gordon. Gordon's system would easily be modified to include the teachings of Hsiao, since the systems share cumulative features, being additive in nature.

Regarding ***claim 40***, Gordon discloses the method discussed above in claim 33, and further teaches of receiving facsimile data via a telephone network (see abstract, and column 5, lines 32 through 40), and converting the received facsimile data into a data file (column 4, line 62 through column 5, line 11, and column 6, lines 4 through 20), wherein the data file is stored into the memory (column 6, lines 34 through 58), and management data corresponding to the data file is generated as a structured document (column 10, lines 31 through 65). However, Gordon fails to specifically teach of converting the received facsimile data into a TIFF file, wherein the TIFF file is stored into the memory, and management data corresponding to the TIFF file is generated as a structured document. Hsiao discloses a method using a communication apparatus connected to a terminal apparatus via a network (see Figs. 1 and 2) comprising receiving e-mail data via the network (column 3, lines 34 through 45, and column 4, lines 40 through 53), storing the received e-mail data into a memory of the communication apparatus (storage unit 90, column 4, lines 40 through 53), and generating management data corresponding to the stored e-mail data, as a structured document (see Fig. 3, column 5, line 36 through column 6, line 9). Hsiao further teaches of receiving facsimile data via a telephone network (column 3, lines 34 through 60), and converting the received facsimile data into a TIFF

file (column 3, line 46 through column 4, line 24), wherein the TIFF file is stored into the memory (column 3, lines 54 through 57), and management data corresponding to the TIFF file is generated as a structured document (see Fig. 3, and column 3, line 46 through column 4, line 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hsiao's teachings in the system of Gordon. Gordon's system would easily be modified to include the teachings of Hsiao, since the systems share cumulative features, being additive in nature.

Regarding ***claim 41***, Gordon and Hsiao disclose the method discussed above in claim 40, and Gordon further teaches of determining whether the data was received via the network or the telephone network (column 10, lines 31 through 49, see listings under "Type").

9. **Claims 26 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (U.S. Patent Number 5,608,786) n view of Kulakowski (WIPO Publication Number WO 97/10668).

Regarding ***claim 26***, Gordon discloses the apparatus discussed above in claim 20, and further teaches of a facsimile transmitter that transmits image data to a destination via a telephone network (column 4, line 62 through column 5, line 11, and column 6, lines 13 through 33), but fails to specifically teach of a scanner that scans a document to obtain image data, a compressor that compresses the image data, and a facsimile transmitter that transmits the compressed image data to a destination via a telephone network. Kulakowski discloses a communication apparatus connected to a terminal apparatus via a network (see Figs.1-3), with the communication apparatus comprising a receiver that receives e-mail data via the network

(page 20, lines 24 through 31), a memory that stores the received e-mail data (memory 34 or 48, page 20, lines 24 through 29), and a generator that generates management data corresponding to the stored e-mail data (page 18, lines 16 through 31), as a structured document, the management data including sender data of the e-mail data (page 18, lines 21 through 23). Kulakowski further teaches of a scanner (seen in Fig. 3) that scans a document to obtain image data (page 11, lines 1 through 7, and page 11, line 26 through page 12, line 19), a compressor that compresses the image data (page 12, lines 29 through 32), and a facsimile transmitter that transmits the compressed image data to a destination via a telephone network (page 11, lines 7 through 25, and page 15, line 18 through page 16, line 7). Therefore, it would have been obvious to a person of ordinary kill in the art to include Kulakowski's teachings in the system of Gordon. Gordon's system would easily include Kulakowski's teachings, as the systems share cumulative features, being additive in nature.

Regarding ***claim 39***, Gordon discloses the method discussed above in claim 33, and further teaches of transmitting image data to a destination via a telephone network (column 4, line 62 through column 5, line 11, and column 6, lines 13 through 33), but fails to specifically teach of scanning a document to obtain image data, compressing the image data, and transmitting the compressed image data to a destination via a telephone network. Kulakowski discloses method using a communication apparatus connected to a terminal apparatus via a network (see Figs.1-3) comprising receiving e-mail data via the network (page 20, lines 24 through 31), storing the received e-mail data into a memory of the communication apparatus (memory 34 or 48, page 20, lines 24 through 29), and generating management data corresponding to the stored e-mail data (page 18, lines 16 through 31), as a structured document, the management data

including sender data of the e-mail data (page 18, lines 21 through 23). Kulakowski further teaches of scanning a document to obtain image data (page 11, lines 1 through 7, and page 11, line 26 through page 12, line 19), compressing the image data (page 12, lines 29 through 32), and transmitting the compressed image data to a destination via a telephone network (page 11, lines 7 through 25, and page 15, line 18 through page 16, line 7). Therefore, it would have been obvious to a person of ordinary kill in the art to include Kulakowski's teachings in the system of Gordon. Gordon's system would easily include Kulakowski's teachings, as the systems share cumulative features, being additive in nature.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
February 20, 2003

MADELEINE NGUYEN
PATENT EXAMINER

AU 2622